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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,856	03/31/2001	Daniel M. Falkoff	UCN-004	7015

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 03/12/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,856

Applicant(s)

FALKOFF ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2001 and 16 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,898,756 (Manning et al.) in view of US 6,167,120 (Kikinis).

As to claims 1, 5, and 11, Manning et al. teaches a transmission inhibiting device that allows DTMF signals to either be sent to a central office 5/received from a central office 5 when those DTMF signals are indicative of actual telephone calls, or to be inhibited from reaching the central office 5, when those DTMF signals are meant to control, program, etc. devices within the home. This is accomplished in Manning et al.

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by attenuating those DTMF signals not meant to be sent to the central office via telephone link 10. Therefore, the situation where DTMF signals are allowed to pass through to/from central office 5 reads on the claimed invention wherein the telephone device is in a connected state. When the DTMF signals are being attenuated, this reads on the claimed invention wherein the telephone is in a disconnected state.

(Abstract, Col. 1, line 53 – Col. 2, line 43, Col. 3, line 64 – Col. 4, line 61 of Manning et al.)

Manning et al. further teaches that instances wherein DTMF signals are to be inhibited include, for example, accessing/controlling/provisioning speed dialers, store and forward functions, as well as controlling/provisioning appliances that may be connected to the telephone wiring in the home. Therefore, a telephone in the home may be used to transmit data entirely within a given telephone link 10. (Col. 6, line 5 – Col. 8, line 67 of Manning et al.)

Note that the device 100 of Manning et al. includes switchable a.c. load circuitry 200 and interface capacitor 250, either of which can be read as the claimed telephone interface. Device 100 further includes a microprocessor 400, read as the claimed control module, which controls device 100. (Fig. 1, Col. 3, line 64 – Col. 4, line 50 of Manning et al.)

What Manning et al. does not teach is a server within a home area network.

However, Kikinis teaches a home server unit 100 which has connected to it various devices such as computers, telephony equipment, etc. (Fig. 1, Col. 2, line 8 – Col. 3, line 2, Col. 3, line 60 – Col. 4, line 29, Col. 6, line 48 – 54 of Kikinis)

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It would have been obvious for one of ordinary skill in the art at the time the invention was made to have used the device of Manning et al. in conjunction with a home area network server inasmuch as the device of Manning et al. already contemplates the control of appliances and the like which are connected to home telephone wiring, which in itself reads on a network. The invention of Kikinis merely provides a variation on the environment by providing a centralized server that provides some of the controlling function for the appliances. Moreover, the invention of Kikinis in one embodiment can use conventional home, telephone wiring as taught by Manning et al. (Col. 3, line 3 – 15 of Kikinis)

As to claim 2, Manning et al. as discussed above provides for telephony services such as speed dialing and store and forward service, while Kikinis provides for attaching various telephony devices, as discussed above, thereby also contemplating providing at least one telephony service to a telephone device located on the home area network.

As to claims 3 and 4, Manning et al. teaches effecting certain telephony services via the use of certain DTMF signals such as 2 pound (##) signals. (Col. 7, lines 51 – 65 of Manning et al.)

As to claims 6 – 9 and 12 – 15, such limitations are drawn merely to a stand-alone answering machine or to a voicemail service resident on the server with the ability to store and play outgoing messages, receive messages and delete messages. Note that while voicemail services are normally associated with a central office or telephone exchange, because Kikinis teaches that the home network can actually provide its own telephone exchange or even micro-PBX features, a voicemail service could very easily

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be implemented in the home network. (Col. 2, lines 27 – 56 of Kikinis) Moreover, such functionality would of course occur when the telephone device is in a disconnected state, because as discussed above, codes used to, for example, delete stored messages, are not meant to be sent to the central office because they are merely control DTMF signals.

As to claim 10, such is merely a limitation allowing for the notification of an incoming call while a telephony device is disconnected, such as when, for example, the telephony device is being used to control an appliance. Because Manning et al, as discussed above, “disconnects” from telephone link 10 by attenuating DTMF signals, there is nothing stopping the device from being able to detect an incoming call from central office 5. Regardless of Manning et al., just like the well known call waiting feature, there is ample motivation for providing notification of an incoming call while a telephony device is otherwise occupied/being used.

As to claims 16 - 18, see the rejection of claims 3 and 4, and furthermore, Kikinis teaches not only the use of a home server, but also access to a remote server. Of course, a remote telephony device could be connected to remote server. (Col. 2, lines 34 – 43 of Kikinis) Also, Kikinis teaches being able to access the home server via external access numbers, in other words, via remote telephony devices, such as checking voice mail on the remote telephone device. (Col. 7, lines 54 – 61 of Kikinis)

As to claims 19 – 22, see the rejection of claims 6 – 9 and 12 – 15 above.

***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,251,692 (Waldman) teaches an old and well known method of disconnecting/switching a telephony device from a telephone line in certain situations. US 5,548,635 (Bradley et al.) teaches a system for controlling equipment within a telephone subscriber's premises using DTMF telephone tones. US 5,864,607 (Rosen et al.) teaches communication with a computer using telephones, wherein a home resident may control a computer's functions via commands sent from a home telephone and vice versa.


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.  
March 4, 2004

  
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